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Docket No.: 61352-050

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Customer No. 20277
Katsuya NOZAWA et. al. : Confirmation No. Unknown
Serial No.: 10/691,500 : Group Art Unit: Unknown
Filed: October 24, 2003 : Examiner: [Signature]
For: METHOD OF ESTIMATING SUBSTRATE TEMPERATURE

RESCISSION OF PREVIOUS NON-PUBLICATION REQUEST

Mail Stop PG Pub
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

A conditional request that the above-identified application not be published under 35 U.S.C. § 122(b) (non publication request) was included with the above-identified application upon filing pursuant to 35 U.S.C. 122(b)(2)(B)(i) along with a petition requesting waiver of the publication rules under 37 CFR § 1.183. We hereby **rescind** the previous non-publication request.

More specifically, upon filing the above application, a petition for non-publication of the application was filed under 37 CFR § 1.183 (copy enclosed) along with a request for non-publication (copy enclosed). As set forth in detail in the petition, the petition requested a waiver of the publication rules for this application that was previously filed in Japan on the basis that the corresponding Japanese application was withdrawn from examination and never published in a foreign country. Importantly, the petition intended to make the request for non-publication of the application conditional on the granting of

the petition, as the petition requested that the request for non-publication be discarded if the petition was denied.

The Office of Petitions denied the petition requesting non-publication in a decision dated May 24, 2004 (copy enclosed). However, the Office of Petitions also indicated that the request to discard the request for non-publication could not be acted upon as it was not clear to the Office of Petitions of what was being requested. Currently, Applicants are unclear if the request for non-publication filed concurrently with the petition has been acted on or discarded by the USPTO.


Accordingly, it is requested at this time that the previously filed request for non-publication of the above-identified application be rescinded due to the fact that the petition requesting waiver of publication rules has been denied. It is respectfully submitted that the foregoing request is being filed within 45 days of mailing of the decision from the Office of Petitions denying the request for non-publication under 37 CFR § 1.183.

If for any reason the above-identified application has been deemed abandoned based on rule 37 CFR § 1.213(c), it is respectfully requested that the foregoing be deemed a request to revive an abandoned application under 37 CFR § 1.137(b) and that the requisite fee be charged to Deposit Account No. 50-0417. It is submitted that if the application is currently deemed abandoned, Applicants are unaware of that fact, and therefore the delay from the time of abandonment to the filing of this petition was unintentional.

If any fee is required in association with the submission of the foregoing request to rescind the non-publication request, it is requested that the fee be charged to Deposit Account No. 50-0417.

Respectfully submitted,

MCDERMOTT, WILL & EMERY


Michael E. Fogarty
Registration No. 36,139

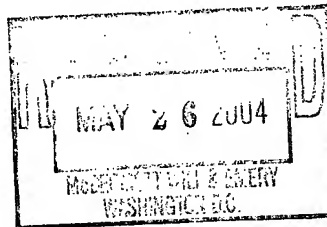
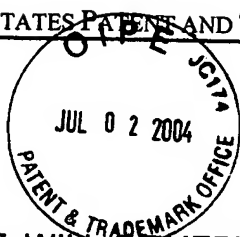
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In re Application of
Nozawa et al.
Application No. 10/691,500
Filed: October 24, 2003
Attorney Dck't. No. 61352-050

OFFICE OF PETITIONS
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ON PETITION
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This is a decision on the petition filed October 24, 2003, requesting (1) under 37 CFR 1.183 waiver of the provisions of 37 CFR 1.213(a) such that the above-identified application not be published, or, in the alternative, if the aforementioned relief not be granted, that (2) the concurrently filed Request for Non-Publication "be discarded."

The petitions are **dismissed**.

Petitioners assert that two counterpart Japanese applications (Nos. 2001-328807 and 2001-328808, both filed October 21, 2001) have been withdrawn such that they never have been published, and, as such, the "primary basis for allowing an application not to be published [having] been satisfied" petitioners request that the instant application not be published other than by way of issuance as a patent. Petitioners further note that the PCT application of which benefit under 35 U.S.C. § 120 is claimed (No. PCT/JP02/11250 filed October 30, 2002) in this "bypass" application only designated the United States, and as such under PCT Article 64(3) the PCT application will not be published (unless this application is published).

As to waiver under 37 CFR 1.183

37 CFR 1.183, by its terms, cannot be invoked to overcome any requirement of the regulations that is also a requirement of the patent statute. Comparison of 35 U.S.C. § 122 (b)(i) with its promulgating regulation 37 CFR 1.213(a), reveals that both statute and regulation condition pre grant publication in the United States upon the mere filing of a counterpart application in a foreign country or under a multilateral international agreement that requires that applications be published at 18 months. That is, pre grant publication is clearly not also conditioned on the ultimate publication—or even the continuing pendency—of the counterpart application in the foreign country or under the multilateral international agreement; only the **filing**. Since the invention filed in the U.S. was the subject of the filed Japanese counterpart applications, then the statutory condition warranting publication of the instant application has been met. It is immaterial that the counterpart Japanese applications were withdrawn or will not now be

published; that they were filed in a country that publishes applications in 18 months is the qualifying and triggering event for publication of the instant application. Accordingly, since petitioner seeks waiver of a condition that is statutory as well as regulatory, the requested waiver simply cannot be granted. The USPTO simply lacks the authority or discretion to relax any requirement of law. See Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998) (the PTO cannot, by rule, or waiver of the rules, fashion a remedy that contravenes 35 U.S.C. §§ 112, 120); A. F. Stoddard v. Dann, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir 1977), (since the USPTO is an executive branch agency, it must follow the strict provisions of the applicable statute). Here, the USPTO lacks the authority and the discretion to waive the language of 37 CFR 1.213(a) as that language is also statutory. See 35 USC 122(b)(i). Petitioner's comment about the "primary objective" of the non publication provision of the rule, which also appears in the statute, is not persuasive. Whatever may be the Primary objective of Congress when it legislates is immaterial if that objective does not appear in the statute.¹ Since the statute conditions U.S. publication on the mere filing of a counterpart application, the USPTO cannot waive the statutory requirement for publication of this application, notwithstanding the withdrawal and consequent non publication of the counterpart Japanese applications.

As to the requested "discard" of the Non Publication request

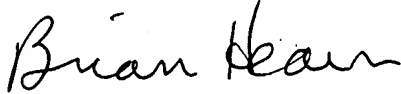
The meaning of petitioner's request is not clear. Petitioner is reminded that a given paper may, under appropriate circumstances, be expunged under 37 CFR 1.59(b), or, say, a non publication request may be "rescinded" if the requirements of the controlling rule are met. See 37 CFR 1.213(b)(1)-(b)(3). Since the request for "discard" is bundled within a paper styled as a petition for the Office of Petitions, this request lacks compliance with 37 CFR 1.4(c). Petitions under 37 CFR 1.59(b) are decided by the Technology Center, and requests for rescission under 37 CFR 1.213(b)(1)-(b)(3) are treated by Pre Grant Publication Division. As such, it would be improper speculation for the Office of Petitions to attempt to divine petitioner's meaning and then itself act on petitioner's request. Petitioner is invited to restate the request in a separate paper dedicated to that purpose and appropriately captioned, and resubmit the amended request to the appropriate part of the USPTO. Chapter 1000 of the MPEP provides

¹ As the Federal Circuit noted when construing § 254 in Southwest Software v. Harlequin, 226 F.3d 852, 56 USPQ2d 1161 (Fed. Cir. 2000):

We begin the process of statutory interpretation with the language of the statute. See Van Wersch v. Department of Health & Human Servs., 179 F.3d 1144, 1148 (Fed. Cir. 1999) (citing VE Holding Corp. v. Johnson Gas Appliance Co., 917 F.2d 1574, 1579, 16 USPQ2d 1614, 1618 (Fed. Cir. 1990)). If the language is clear, the plain meaning is conclusive. See *id.* at 1152 (holding that Congressional intent, as clearly expressed in legislative history, could not "trump the irrefutably plain [statutory] language that emerged when Congress actually took pen to paper").

guidance as to the delegated authority within the USPTO for treating various requests. As a courtesy, a copy of a request for rescission of a prior non publication request is being enclosed with this decision.

Telephone inquiries relative to this decision should be directed to the undersigned at (703) 305-1820.



Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Enclosure:

Blank form captioned "Rescission of Previous Non Publication Request"